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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,880	11/27/2000	James R. Henshaw	107979	4029

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EXAMINER

GUADALUPE, YARITZA

ART UNIT PAPER NUMBER

2859

DATE MAILED: 06/23/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/721,880

Applicant(s)

HENSHAW ET AL.

Examiner

Yaritza Guadalupe

Art Unit

2859

-- The MAILING DATE of this communication appears on the cover sheet with the correspond nc address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 April 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 31-52 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 31-36 and 38-51 is/are rejected.
- 7) ☒ Claim(s) 37 and 52 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other:

### DETAILED ACTION

In response to the Supplemental Response and Attachment filed April 11, 2003.

#### *Claim Rejections - 35 USC § 103*

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 31 – 35, 38 – 41 and 43 – 51 are rejected under 35 U.S.C. 103 ( a ) as being unpatentable over Morrison et al. ( US 5,063,685 ) in view of Reilly ( US 5,826,346 ).

Morrison et al. discloses an apparatus comprising a measurement scale ( 26 ), a read-head ( 54 ) relatively moveable along the scale for reading the scale ( See Column 2, lines 2 – 7 ), and an elongate track ( 50 ) for holding the measurement scale.

Morrison et al. does not disclose the elongated track having a channel and magnetic material disposed in the channel for magnetically attracting the scale as stated in claims 31 - 32, 38 - 40, 43 - 45 and 49 – 51. Morrison et al. does not disclose the ferrite rubber material as

Art Unit: 2859

stated in claims 34, 41, 46 and 50. Morrison et al. does not disclose the scale being magnetic or magnetisable as stated in claims 35 and 47. Morrison et al. does not disclose the track made of aluminum as stated in claim 33.

With respect to claims 31 - 32, 38 - 40, 43 - 45 and 49 - 51 : Reilly discloses an elongate track ( 12 ) for holding a measuring scale, the track having a channel / slot ( 58 ) wherein the track is adapted for attracting magnetically, by means of a magnetic material / strip ( 62 ) disposed on the channel / slot, a magnetisable scale ( 60 ) to the track ( See Column 3, lines 56 - 62 ), the track being extruded ( See Column 2, lines 65 - 66 ), and a scale tensioner ( 64, 66 ) for tensioning the scale on the track ( See Columns 3 and 4, lines 65 - 67 and 1 - 7 respectively ). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace elongated track disclosed by Morrison et al. with an elongated track and magnetic slot as taught by Reilly in order to properly and securely retain in position the scale by providing a primary and secondary means for attachment that will avoid unexpected displacement during measurements.

With respect to claims 34, 41, 46 and 50 : Morrison et al. and Reilly disclose a magnetic material / strip (62) but does not disclose the particular magnetic material / strip used. The use of the particular type of magnetic material claimed by applicant, i.e., ferrite rubber, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a magnetic material

Art Unit: 2859

is provided for securely attaching the scale into the channel, as already suggested by Morrison et al. and Reilly, 2) the magnetic material claimed by Applicant and the magnetic material used by Morrison et al. and Reilly are well known alternate types of magnetic materials which will perform the same function, if one is replaced with the other, of securely attaching the scale into the channel, and 3) the use of the particular type of magnetic material by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of magnetic material that a person having ordinary skill in the art would have been able to provide using routine experimentation in order to securely attach the scale into the channel as already suggested by Morrison et al. and Reilly.

Regarding claims 34 and 46 : Morrison et al. and Reilly discloses a measuring gage but does not disclose the particular material used to make the track ( 12 ). The particular type of material used to make the track, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant's apparatus, i.e., suitability for the intended use of Applicant's apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960 ) where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

Art Unit: 2859

3. Claims 31 - 51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nelle (US 5,511,321 ) in view of Reilly ( US 5,826,346 ).

Nelle discloses an apparatus comprising a measurement scale ( 1 ), a read-head / scanning device ( 8 ) relatively moveable along the scale for reading the scale ( See Column 2, lines 40 – 43 ), and an elongate track ( 2 ) having a channel / groove for holding the measurement scale (See Column 2, line 31 ). Nelle further discloses a scale tensioner ( 3 ) including a preloadable member ( 3a ) operable to urge the scale into tension and a resilient part and loading part for preloading and releasing the preload.

Nelle does not disclose the magnetic material disposed in the channel for magnetically attracting the scale as stated in claims 31 – 32, 40, 43 – 44, 49 and 51. Nelle does not disclose the ferrite rubber material as stated in claims 34, 41, 46 and 50. Nelle does not disclose the scale being magnetic or magnetisable as stated in claims 35 and 47. Nelle does not disclose the track made of aluminum as stated in claims 33 and 36. Nelle does not disclose the track made of magnetic ferrite rubber as stated in claims 34 and 46. Nelle does not disclose the track having a concave face as stated in claim 37. Nelle does not disclose the scale and magnetic material being spaced as stated in claims 42 and 48.

With respect to claims 31 – 32, 40, 42 – 44, 48 - 49 and 51 : Reilly discloses an elongate track (12) for holding a measuring scale, the track having a channel / slot ( 58 ) wherein the track is adapted for attracting magnetically, by means of a magnetic material / strip ( 62 ) disposed on

Art Unit: 2859

the channel / slot, a magnetisable scale ( 60 ) to the track ( See Column 3, lines 56 – 62 ), said scale and magnetic material being somewhat spaced from each other, the track being extruded (See Column 2, lines 65 – 66 ), and a scale tensioner ( 64, 66 ) for tensioning the scale on the track ( See Columns 3 and 4, lines 65 – 67 and 1 – 7 respectively ). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the invention was made to replace elongated track disclosed by Nelle with an elongated track and magnetic slot as taught by Reilly in order to properly and securely retain in position the scale by providing a primary and secondary means for attachment that will avoid unexpected displacement during measurements.

With respect to claims 34, 41, 46 and 50 : Nelle and Reilly disclose a magnetic material / strip ( 62 ) but does not disclose the particular magnetic material / strip used. The use of the particular type of magnetic material claimed by applicant, i.e., ferrite rubber, absent any criticality, is considered to be nothing more than a choice of engineering skill, choice or design, because 1) neither non-obvious nor unexpected results, i.e., results which are different in kind and not in degree from the results of the prior art, will be obtained as long as a magnetic material is provided for securely attaching the scale into the channel, as already suggested by Nelle and Reilly, 2) the magnetic material claimed by Applicant and the magnetic material used by Nelle and Reilly are well known alternate types of magnetic materials which will perform the same function, if one is replaced with the other, of securely attaching the scale into the channel, and 3) the use of the particular type of magnetic material by Applicant is considered to be nothing more than the use of one of numerous and well known alternate types of magnetic material that a

Art Unit: 2859

person having ordinary skill in the art would have been able to provide using routine experimentation in order to securely attach the scale into the channel as already suggested by Nelle and Reilly.

Regarding claims 33 and 36: Nelle and Reilly discloses a measuring apparatus having a track ( 1 ) made of an alloy but also gives the option of using glass, ceramics or any other suitable material ( See Column 2, lines 45 and 65 – 67 ). The particular type of material used to make the track, absent any criticality, is only considered to be the use of a “ preferred ” or “ optimum ” material out of a plurality of well known materials that a person having ordinary skill in the art at the time the invention was made would have find obvious to provide using routine experimentation based, among other things, on the intended use of Applicant’s apparatus, i.e., suitability for the intended use of Applicant’s apparatus. See In re Leshin, 125 USPQ 416 (CCPA 1960 )-where the court stated that a selection of a material on the basis of suitability for intended use of an apparatus would be entirely obvious.

***Allowable Subject Matter***

4. Claims 37 and 52 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.



*Response to Arguments*

5. Applicant's arguments filed April 11, 2003 have been fully considered but they are not persuasive.

Applicant arguments regarding Reilly not disclosing or suggesting a magnetic force that allows a relative movement between the scale and the track is not persuasive. Reilly clearly teaches a device comprising means ( 62 ) for magnetically attracting a scale ( 60 ) to the track capable of allowing a relative movement between the scale and the track since it is inherent that any means for securing will allow a relative movement when an external force is applied. Also, It should be emphasized that "apparatus claims must be structurally distinguishable from the prior art." MPEP 2114. In *In re Danly*, 263 F. 2d 844, 847, 120 USPQ 528, 531 (CCPA 1959) it was held that apparatus claims must be distinguished from prior art in terms of structure rather than function. In *Hewlett-Packard Co v Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990), the court held that: "Apparatus claims cover what a device is, not what it does." (emphases in original). That is, in an apparatus claim, if a prior art structure discloses all of the structural elements in the claim, as well as their relative juxtaposition, then it reads on the claim, regardless of whether or not the function for which the prior art structure was intended is the same as that of the claimed invention.

*Conclusion*

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yaritza Guadalupe whose telephone number is (703)305 -5676. The examiner can normally be reached on 9:00 AM - 6:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Diego F.F. Gutierrez can be reached on (703) 308-3875. The fax phone numbers for the organization where this application or proceeding is assigned are (703)308-7722 for regular communications and (703)308-7722 for After Final communications.

Art Unit: 2859

- Any inquiry of a general nature or relating to the status of this application or proceeding  
should be directed to the receptionist whose telephone number is (703)308-0956.



Yaritza Guadalupe  
Patent Examiner  
Art Unit 2859  
June 18, 2003

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